

Serial No. 10/783,499

Docket No. Zipfel I

**REMARKS****Summary of the Recent Prosecution History**

The Notice of Panel Decision from Pre-Appeal Brief Review mailed 03/04/2009 indicated that prosecution was being reopened, and an Office action rejecting all claims was issued on 06/11/2009. That Office action asserted a new ground of rejection under 35 USC 112 and repeated the pre-appeal rejections based on prior art.

The undersigned attorney thereafter held several informal telephone conversations with Examiner Parker in which applicant asserted that the termination of applicant's appeal by the Pre-Appeal Brief Panel was improper, for at least the following reasons:

1. The rejection of 35 USC 112 was without foundation in that the examiner's stated view—that it was “unclear” as to what elements in the specification correspond to the different means—is belied by the fact that the examiner had no difficulty throughout this long prosecution in determining which portions of applicant's disclosed embodiments correspond to the various means of applicant's claims. See, for example, the examiner's extensive analysis in the Office action of 04/29/2008.
2. Since claims 63-69 do not contain any means-plus-function limitations, the rejection of those claims under 35 USC 112 was improper on its face.
3. The Office action of 06/11/2009 did not set forth any new grounds of rejection based on prior art.

Notwithstanding applicant's concerns about improper termination of applicant's appeal as just stated, the thought was ultimately expressed by Examiner Parker that if certain amendments were made to independent claims 1, 9 and 34, the application might be regarded by the Office as being in condition for allowance, which would render that issue moot. Applicant acceded to Examiner Parker's suggestion that a clarifying paper be sent by the Office and that the period for response to the Office action of 06/11/2009

Serial No. 10/783,499

Docket No. Zipfel 1

would be reset.

That clarifying paper was mailed on 09/24/2009 and this is a response thereto.

**Claims 1, 9 and 34—Rejection under 35 USC 112**

Independent claims 1, 9 and 34 have all been amended in the manner suggested in the paper signed by Examiner Parker and mailed on 09/24/2009. These amendments even more clearly than heretofore tie various functional recitations into various “means” recited in these claims.

Although not explicitly stated in the paper of 09/24/2009, applicant believes that it is Examiner Parker’s view such amendments would overcome the outstanding rejection under 35 USC 112 because, in the Examiner’s view, such amendments “would bring into the means plus function language the [relevant] portions of the specification...”

In any event, it is noted that the “means for generating” of applicant’s claim 1, taken as exemplary, encompasses elements 33, 33a, 33b, 35, 37, 45, 47 and 55 in the embodiment of FIG. 4A and as well as corresponding elements in the other disclosed embodiments. And the “means for applying” of applicant’s claim 1, taken as exemplary, encompasses elements 39, 41, 43 and 49 in the embodiment of FIG. 4A and as well as corresponding elements in the other disclosed embodiments.

**Claims 1, 9 and 34—Rejection under 35 USC 102/103**

Applicant again points to the distinctions noted by applicant throughout the prosecution with respect to, for example, the recited means-plus-function structures as making the claims allowable. Accordingly, applicant respectfully solicits allowance of these claims based on the arguments previously made by applicants. Those arguments are summarized in the paper “REASONS FOR REQUEST OF PRE-APPEAL BRIEF REVIEW” filed by applicant on 10/27/2008.

Serial No. 10/783,499

Docket No. Zipfel 1

**Claim 63—Rejection under 35 USC 103**

Independent claim 63 does not contain any means-plus-function recitations and this claim has not been amended. However, applicant hereby again asserts that this claim is allowable based on, at least, its recitation of the characteristics of the passband and stop band of the load filters at lines 7-9.

Applicant has pointed out this distinction on at least four separate occasions during the prosecution but does not see how any Office action has explained how the cited prior art discloses that aspect of the load filters or renders it obvious. Reference may be made to p. 2 of the above-noted paper “REASONS FOR REQUEST OF PRE-APPEAL BRIEF REVIEW” filed by applicant on 10/27/2008.

**Withdrawn Dependent Claims**

Dependent claims 12, 18, 27-29 and 40 were withdrawn in response to the Restriction Requirement of 09/22/2004. In light of applicant's belief that the respective independent claims are allowable, there is not believed to be any basis for the examiner to continue to assert that these claims are directed to separate inventions.

Accordingly, rejoinder and allowance of these claims is respectfully requested.

**Final Rejection Would Be Premature**

It is believed that the application is in condition for allowance.

If, however, there is to be any further Office action rejecting claims, it is submitted that any such further Office action can not properly be made FINAL, for at least the following reasons:

1. Claims 1, 9 and 34 have been amended to do nothing more than make even clearer than was already the case that certain recited functional recitations were positive limitations on the “function” of various recited “means plus function” elements. Whether or not those recitations were previously regarded by the examiner as to be given any patentable weight, the

Serial No. 10/783,499

Docket No. Zipfel 1

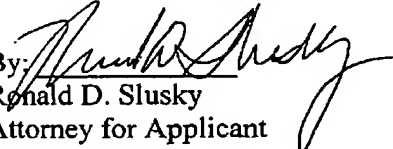
examiner nonetheless purported to show in great detail how each of the claim limitations, functional or not, was anticipated by the prior art.

This being so, any new grounds of rejection will not have been made necessary by applicant's amendments.

2. Claim 63, which applicant asserts to be allowable, has not been amended, making it premature for any further Office action based on any new ground of rejection of this claim to be FINAL. See MPEP 706.07(a) which provides that an Office action should not be made final if new grounds of rejection are entered as to any unamended claim, even if other claims are amended.

Reconsideration is requested.

George G. Zipfel, Jr.

By:   
Ronald D. Slusky  
Attorney for Applicant  
Reg. No. 26,585  
(212) 246-4546

Office of Ronald D. Slusky  
Registered Patent Attorney  
353 West 56<sup>th</sup> St—Suite 5L  
New York, N.Y. 10019  
Date: 12/17/09